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EXAMINER

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/810,625

Applicant(s)

TORNABENE ET AL.

Examiner

J. Bret Dennison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/27/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/24/02, 8/25/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to the Appeal Brief for Application Number 09/810,625 received on 27 December 2005.
2. Claims 1-55 are presented for examination.
3. Applicant's arguments, see Appeal Brief, filed 27 December 2005, with respect to the rejection(s) of claim(s) 1-55 under Sonnenreich have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Claim Objections

Claim 2 is objected to because of the following informalities:

4. Claim 2 recites the limitation "wherein sending the invitation comprising using an e-mail message." Examiner will interpret the limitation to read, "wherein sending the invitation comprises using an e-mail message." Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 39 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 39 includes the limitation, "wherein the computer readable medium is a propagated signal", which appears to be nothing more than a signal carrying instructions for execution not tangibly embodied in a manner so as to be executable and is thus non-statutory for failing to be in one of the categories of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 22 recites the limitation, "offering new services based upon the current members of the group including the new member". It is vague and unclear to Examiner what this limitation means. Examiner is unclear as to what new services are offered and to whom.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8-13, 15, 22-28, 34-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Waesterlid et al. (U.S. Patent Number 6,993,325).

7. Regarding claims 1 and 35, Waesterlid disclosed a computer implemented method of sharing information among members of a group, the method comprising:

- storing information about all current members of a group (Waesterlid, col. 2, lines 15-20, col. 6, lines 35-40, 50-55);
- receiving instructions from at least one current member to invite at least one prospective member to join the group (Waesterlid, col. 7, lines 4-6);
- sending an invitation to the prospective member to join the group (Waesterlid, col. 7, lines 4-6);
- receiving an affirmative response from the prospective member (Waesterlid, col. 7, lines 8-15);
- adding the prospective member to of the group as a new member (Waesterlid, col. 7, lines 10-15); and
- automatically updating services to current members to account for the new member (Waesterlid, col. 2, line 34, col. 7, lines 13-20).

Claim 35 includes a computer program with limitations substantially similar to the limitations of claim 1 and is therefore rejected under the same rationale.

8. Regarding claim 8, Waesterlid disclosed the limitations, substantially as claimed, as described in claim 1, including wherein automatically updating services comprises providing a list of current members that includes the new member (Waesterlid, Fig. 6B, col. 2, lines 15-20, col. 8, lines 40-45).

9. Regarding claim 9, Waesterlid disclosed the limitations, substantially as claimed, as described in claim 1, including wherein automatically updating services comprises providing information in an address book that includes address information for the new member (Waesterlid, col. 7, line 63 through col. 8, line 45-50, Waesterlid disclosed the update message including address information for the new member).

10. Regarding claim 10, Waesterlid disclosed the limitations, substantially as claimed, as described in claim 9, including updating the address book based upon information entered by the current members of the group (Waesterlid, col. 8, lines 54-60, Waesterlid disclosed the client application taking appropriate action to add, delete, or modify member records in the corresponding group database, wherein modifying member records from the update message is based from members being entered by those members).

11. Regarding claim 11, Waesterlid disclosed the limitations, substantially as claimed, as described in claim 1, including wherein automatically updating services

comprises providing information in a calendar that includes information for the new member (Waesterlid, col. 1, lines 35-43).

12. Regarding claim 12, Waesterlid disclosed the limitations, substantially as claimed, as described in claim 11, including updating the calendar based upon information entered by the current members of the group (Waesterlid, col. 1, lines 35-43).

13. Regarding claim 13, Waesterlid disclosed the limitations, substantially as claimed, as described in claim 11, including inviting current group members to attend an event and automatically recording the event in the calendar (Waesterlid, col. 1, lines 35-43).

14. Regarding claim 15, Waesterlid disclosed the limitations substantially as claimed as described in claim 1, including wherein automatically updating services comprises enabling current members of the group to send instant messages to other current members of the group including the new member (Waesterlid, col. 1, lines 25-35).

15. Regarding claim 22, Waesterlid disclosed the limitations substantially as claimed as described in claim 1, including offering new services based upon the current members of the group including the new member (Waesterlid, col. 7, lines 10-20,

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Waesterlid disclosed providing the new member with a list of the current members of the group).

16. Regarding claim 23, Waesterlid disclosed the limitations substantially as claimed as described in claim 1, including wherein automatically updating services comprises providing information in an instant messaging buddy list that includes information for the new member (Waesterlid, col. 1, lines 25-35, col. 8, lines 40-45).

17. Regarding claim 24, Waesterlid disclosed a communication system for sharing information among members of a group comprising

a group administrator for processing information about the current members of the group (Waesterlid, col. 7, line 2-8);

a group communicator cooperating with the group administrator for delivering and exchanging information with current and prospective group members (Waesterlid, col. 7, line 2-8, 25-40, Waesterlid disclosed the administrator able to send out membership requests and update requests); and

a group information updater cooperating with the group communicator and group administrator for providing automatically updated services to current members including a new member, wherein in response to an affirmative response to an invitation to a prospective member to join the group, the group information updater is instructed by the group communicator to add the prospective member of the group (Waesterlid, col. 7, lines 2-20).

18. Regarding claim 25, Waesterlid disclosed the limitations substantially as claimed as described in claim 24, including wherein the group administrator further comprises:

a group member profile server for updating data related to current members including the new member (Waesterlid, col. 6, lines 35-40, master group database, col. 8, lines 1-2 member data); and

a database connected to the group member profile server for storing data related to current members including the new member (Waesterlid, col. 6, lines 35-40, master group database, col. 8, lines 1-2 member data).

19. Regarding claim 26, Waesterlid disclosed the limitations substantially as claimed as described in claim 24, including wherein the group communicator further comprises:

an instant message host in communication with a client system (Waesterlid, col. 6, lines 30-45, client/server approach); and

a login server in communication with a client system and the instant message host for determining whether the client is authorized to access the instant message host (Waesterlid, col. 1, lines 30-35, ICQ).

20. Regarding claim 27, Waesterlid disclosed the limitations substantially as claimed as described in claim 26, including wherein the instant message host further comprises:

an instant message server for sending and receiving data (Waesterlid, col. 1, lines 30-35, ICQ).; and

a domain server cooperating with the instant message server for providing supporting functions of the instant message host (Waesterlid, col. 1, lines 30-35, ICQ).

21. Regarding claim 28, Waesterlid disclosed the limitations substantially as claimed as described in claim 27, including wherein the instant message host further comprises a routing gateway connected to the instant message server (Waesterlid, col. 3, lines 20-25).

22. Regarding claim 34, Waesterlid disclosed a graphical user interface for inviting a prospective member of a group to join the group, the graphical user interface comprising:

an invitation for the prospective member to join the group (Waesterlid, col. 7, lines 1-10);

a name of the group (Waesterlid, col. 10, lines 35-45);

a list of one or more current members of the group (Waesterlid, col. 7, lines 10-25, col. 8, lines 40-46); and

a tool for the prospective member to respond to the invitation (Waesterlid, col. 7, lines 10-15).

23. Regarding claim 36, Waesterlid disclosed the limitations substantially as claimed as described in claim 35, including wherein the computer readable medium is a disc (Waesterlid, col. 4, lines 35-60).

24. Regarding claim 37, Waesterlid disclosed the limitations substantially as claimed as described in claim 35, including wherein the computer readable medium is a client device (Waesterlid, col. 6, lines 49-65).

25. Regarding claim 38, Waesterlid disclosed the limitations substantially as claimed as described in claim 35, including wherein the computer readable medium is a host device (Waesterlid, col. 5, lines 30-50).

26. Regarding claim 39, Waesterlid disclosed the limitations substantially as claimed as described in claim 35, including wherein the computer readable medium is a propagated signal (Waesterlid, col. 4, lines 35-60).

27. Regarding claim 40, Waesterlid disclosed the limitations substantially as claimed as described in claim 1, including wherein the current members of the group comprise members of a family (Waesterlid, col. 1, lines 20-25).

28. Regarding claim 41, Waesterlid disclosed the limitations substantially as claimed as described in claim 1, including wherein the prospective member comprises a relative of a current member of the group (Waesterlid, col. 1, lines 20-25).

29. Regarding claim 42, Waesterlid disclosed the limitations substantially as claimed as described in claim 1, including in which storing information about all members of a group comprises storing information about all members of a private group (Waesterlid, col. 6, lines 35-40, col. 8, lines 1-5).

30. Regarding claim 43, Waesterlid disclosed the limitations substantially as claimed as described in claim 1, including in which storing information about all members of a group comprises storing information about all members of a public group (Waesterlid, col. 6, lines 35-40, col. 8, lines 1-5).

31. Regarding claim 44, Waesterlid disclosed the limitations substantially as claimed as described in claim 1, including wherein the invitation comprises a personalized message to the prospective member (Waesterlid, col. 7, lines 3-6).

32. Regarding claims 45-53, Waesterlid disclosed the limitations substantially as claimed as described in claim 1, including wherein a group founder authorizes invitations to prospective members and has the power to add and delete users from the group and promoting and demoting group members (Waesterlid, col. 7, lines 1-20, col. 8, lines 50-65).

33. Regarding claim 54, Waesterlid discloses the limitations substantially as claimed as described in claim 1, including providing a notification of the response to one or more current members (Waesterlid, col. 7, lines 10-15).

34. Regarding claim 55, Waesterlid disclosed the limitations substantially as claimed as described in claim 1, including treating the new member as a current member (Waesterlid, Fig. 6B, 216).

Claims 1, 24, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Engel et al. (U.S. Patent Number 6,028,866).

35. Regarding claims 1, 24, 34 and 35, Engel disclosed a computer implemented method of sharing information among members of a group, the method comprising:
storing information about all current members of a group (Engel, col. 4, lines 7-12);

receiving instructions from at least one current member to invite at least one prospective member to join the group (Engel, col. 3, lines 60-67, col. 4, lines 33-45);

sending an invitation to the prospective member to join the group (Engel, col. 3, lines 60-67);

receiving an affirmative response from the prospective member (Engel, col. 4, lines 1-7);

adding the prospective member to of the group as a new member (Engel, col. 4, lines 10-17); and

automatically updating services to current members to account for the new member (Engel, col. 4, lines 60-67).

Claim 24 includes a communication system describing elements that would be necessary to perform the method of claim 1, therefore claim 24 is rejected under the same rationale.

Claim 34 includes a user interface allowing users to perform the method of claim 1. Since Engel disclosed the user of the apparatus making the decision whether to join or not (Engel, col. 4, lines 20-23) and a display means that allows users to select end apparatuses (Engel, col. 4, lines 58-67), claim 34 is rejected under the same prior art as being substantially similar to claim 1.

Claim 35 includes a computer program with limitations substantially similar to the limitations of claim 1 and is therefore rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waesterlid.

36. Regarding claims 2-4, Waesterlid disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the Membership Request Message follows a standard protocol that includes a header and information field (Waesterlid, col. 10, lines 35-47). Waesterlid also disclosed the use of instant messaging, chat, and email provided to users of the system as all standard protocols for communicating amongst group members (Waesterlid, col. 1, lines 25-35, col. 4, lines 8-20).

Waesterlid did not explicitly state wherein sending the invitation comprises using an e-mail message, instant message, or using an on-line chat room.

However, e-mail, instant messaging, and on-line chat are all standard forms of communication that use a protocol, which includes a header and information field. Since Waesterlid did not limit the Membership Request Message to a specific type of communication, it would have been obvious for a network administrator to look for any standard types of communication, including email, instant messaging, and on-line chat, to send this request to provide users with a system that can be implemented across well known standards of communication that are already publicly used across the internet.

It would have also been obvious to one of ordinary skill in the art at the time the invention was made to incorporate these types of communication into Waesterlid since they are all standard existing technologies that facilitate interaction among the members of a group (Waesterlid, col. 1, lines 25-35).

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37. Regarding claims 5-7, Waesterlid disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the Membership Reply Message follows a standard protocol that includes a header and information field (Waesterlid, col. 10, lines 50-55). Waesterlid also disclosed the use of instant messaging, chat, and email provided to users of the system as all standard protocols for communicating amongst group members (Waesterlid, col. 1, lines 25-35, col. 4, lines 8-20).

Waesterlid did not explicitly state wherein receiving the response comprises using an e-mail message, instant message, or using an on-line chat room.

However, e-mail, instant messaging, and on-line chat are all standard forms of communication that use a protocol, which includes a header and information field. Since Waesterlid did not limit the Membership Reply Message to a specific type of communication, it would have been obvious for a network administrator to look for any standard types of communication, including email, instant messaging, and on-line chat, to send this request in order to provide users with a system that can be implemented across well known standards of communication that are already publicly used across the internet.

It would have also been obvious to one of ordinary skill in the art at the time the invention was made to incorporate these types of communication into Waesterlid since they are all standard existing technologies that facilitate interaction among the members of a group (Waesterlid, col. 1, lines 25-35).

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38. Regarding claim 14, Waesterlid disclosed the limitations substantially as claimed as described in claim 1. Waesterlid also disclosed two approaches that may be taken to communication between member groups, including the client/server approach, and the peer-to-peer approach (col. 6, lines 30-67).

Waesterlid did not explicitly state including wherein automatically updating services comprises providing an on-line forum for current members of the group to chat with other current members of the group including the new member.

However, an on-line forum is a standard form of communication used by client/server systems, in which a protocol is used, which includes a header and information field in order to send the messages to the forum. Since Waesterlid did not limit the communication protocol to a specific type of communication, it would have been obvious for a network administrator to look for any standard types of communication, on-line forums, to send messages in order to provide users with a system that can be implemented across well known standards of communication that are already publicly used across the internet.

Claims 16-21, 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waesterlid in view of Sonnenreich (U.S. 5,974,446).

39. Regarding claims 16-21, Waesterlid disclosed the limitations, substantially as claimed as described in claim 1. Waesterlid disclosed the use of email to facilitate interaction among the members of a group (Waesterlid, col. 1, lines 25-30). Waesterlid

did not explicitly state including wherein members of the group can share data files with each other, wherein the data files include multimedia such as digital images and photographs, and text files.

However, it would have been obvious for one of ordinary skill in the art at the time the invention was made that standard emailing systems provide senders with the ability to attach files to send to the recipient, the files being any type of file.

Since Waesterlid disclosed email as an existing technology to provide for communication between members, it would have been obvious to one of ordinary skill in the art at the time the invention was made that members of the group of Waesterlid have the capability to send multimedia and text files to share amongst other members by using email as the type of communication.

In an analogous art, Sonnenreich disclosed a system for communicating between server and clients wherein clients and teacher communicate with each other through instant messaging (col. 4, lines 18-30) in which members of the group can share data files with each other, wherein the data files include multimedia (Sonnenreich, col. 4, lines 44-50) and text files (Sonnenreich, col. 4, lines 1-10, 25-44).

Both Waesterlid and Sonnenreich provide systems in which members of a group communicate through standard protocols. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate the sharing of data/multimedia, as taught by Sonnenreich, into Waesterlid to provide users with an enhanced communication system that provides extra services allowing

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members of an affinity group to share common interests such as music (Waesterlid, col. 1, lines 20-25).

40. Regarding claims 29-33, Waesterlid disclosed the limitations substantially as claimed as described in claim 24. Waesterlid did not explicitly state having a login server providing a graphical user interface for members of the system.

In an analogous art of shared groups, Sonnenreich disclosed Sonnenreich disclosed a system for communicating between server and clients wherein clients and teacher communicate with each other, in which clients provide personal identification and information to gain access and start exchanging information (Sonnenreich, col. 6, lines 25-67).

Both Waesterlid and Sonnenreich provide systems in which members of a group communicate through standard protocols. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate the log in functionality of Sonnenreich into Waesterlid in order to provide a secure system providing only authorized users with the services of the system.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing

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responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.


In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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